

## **REMARKS**

In the Official Action, the Examiner rejected claims 1-27. Reconsideration of the claims is respectfully requested in view of the remarks set forth below.

### **Rejections under 35 U.S.C. § 102**

The Examiner rejected claims 1 and 3-27 under 35 U.S.C. § 102(b) as being anticipated by Ewing et al. (U.S. Patent No. 5, 949,974). Applicants respectfully traverse this rejection.

Anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under Section 102, a single reference must teach each and every element or step of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Thus, if the claims recite even one element not found in the cited reference, the reference does not anticipate the claimed invention.

The present application (Pub. No. U.S. 2001/0007140 A1, hereinafter "Pub. '140") is directed to providing an operating system-independent user feedback mechanism for a computer system. Pub. '140, paragraph 3. As described in the background section of the present application, the operating system and system monitor may be unavailable during certain critical times, such as initialization/power-up or operation and low power mode. *See* Pub. '140, paragraphs 5 and 6. To address these shortcomings of prior systems, the present system is directed to providing a separate user feedback mechanism to monitor a plurality of

operating conditions of the computer system and to alert users to the plurality of operating conditions independently of an operating system of the computer system. Pub. '140, paragraph 8. The presently recited user feedback mechanism includes a number of hardware and software elements which allow the user feedback mechanism to monitor operating conditions (including fault conditions) of the computer system and to alert a user to the operating conditions independently of the operating system.

As clearly illustrated in Fig. 1 of the present application, the feedback mechanism includes an O/S interface 110, a BIOS interface 112 and an ACPI interface 114, which allow operating system independent functionality. Thus, independent claims 1, 12 and 21 each recite a user feedback mechanism comprising "an operating system interface coupled to the operating system, a basic input/output system (BIOS) interface coupled to a BIOS of the computing system and an advanced configuration and power interface (ACPI) interface coupled to ACPI logic of the computing system."

In contrast to the recited subject matter, the Ewing reference is directed to power management in a network, and more particularly, to a system for reading the status and for controlling the power supplies of appliances connected to computer networks. *See e.g.*, Col. 1, lines 8-10; col. 4, lines 13-15. In accordance with the Ewing reference, an SNMP network comprises a power manager 20 in communication with a number of SNMP agents 22 and 24 located at remote nodes. Col. 5, lines 31-34. The SNMP manager 20 may comprise a commercial product such as IBM NETVIEW/6000 or HP OPENVIEW. Col. 5, lines 34-36. When a problem at a remote node is detected, the corresponding SNMP agent issues an alarm that identifies the problem by type and node address. Col. 7, lines 52-54.

The Ewing reference does not disclose or suggest a user feedback mechanism comprising the elements recited in the present claims which allow a user to monitor operating conditions of the computer system on a display panel. Specifically, the Ewing reference does not disclose or suggest a BIOS interface or an ACPI interface. In fact, the Ewing reference makes absolutely no reference to a BIOS or ACPI logic, much less a feedback mechanism comprising interfaces configured to interact with such features. If the Examiner is relying on a theory of inherency, Applicants respectfully remind the Examiner that the extrinsic evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999) (Emphasis Added). The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. *Id.* In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

Applicants respectfully submit that the Ewing reference does not disclose or suggest a user feedback mechanism comprising a BIOS interface coupled to the BIOS of a computer system or an ACPI interface coupled to ACPI logic of a computer system, as recited in each of the independent claims. Because independent claims 1, 12 and 21 recite subject matter not disclosed in the Ewing reference, the Ewing reference cannot possibly anticipate the present claims. Accordingly, Applicants respectfully request withdrawal of the Examiner's rejection under 35 U.S.C. § 102 and allowance of claims 1-27.

### **Rejections under 35 U.S.C. § 103**

The Examiner rejected claim 2 under 35 U.S.C. § 103(a) as being unpatentable over Ewing et al. (U.S. Patent No. 5, 949,974) in view of Hawkins et al. (U.S. Patent No. 6,304,244 B1). Applicants respectfully traverse this rejection.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).

Claim 2 is dependent on claim 1 which was rejected under 35 U.S.C. § 102. For at least the reasons discussed above, Applicants respectfully submit that the cited references, taken alone or together, fail to disclose all of the elements recited in the present claims. The Examiner only cites the Hawkins reference as disclosing a liquid crystal display panel. However, there is no suggestion of how the LCD display panel might be used in the Ewing system in a manner that would lead to the invention as recited in claim 1. Applicants further note that the Hawkins reference does not cure the deficiencies of the Ewing reference as discussed above with regard to the independent claims. Accordingly, none of the cited references taken alone or together, can possibly render the recited subject matter obvious. In view of these remarks, Applicants respectfully request withdrawal of the Examiner's

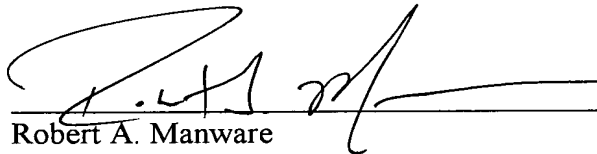
rejections under 35 U.S.C. § 103(a) and allowance of dependent claim 2 for the reasons set forth above.

**Conclusion**

In view of the remarks set forth above, Applicants respectfully request allowance of claims 1-27. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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Robert A. Manware  
Registration No. 48,758  
(281) 970-4545

**HEWLETT-PACKARD COMPANY**  
Intellectual Property Administration  
Legal Department, M/S 35  
P.O. Box 272400  
Fort Collins, Colorado 80527-2400